



0171.39361X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: S. BOUET, et al.

Serial No.: 09/725,935

Filed: November 30, 2000

For: A METHOD OF AND A SYSTEM FOR DISTRIBUTING
ELECTRONIC CONTENT

Group: 3621

Examiner: David Q. LE

**REQUEST FOR RECONSIDERATION OF
FINAL REJECTION-EXPEDITED PROCEDURE IS REQUESTED**

BOX AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 19, 2003

Sir:

Reconsideration and withdrawal of the final rejection set forth in the Office Action of June 19, 2003 are respectfully requested.

The grounds for rejection in the June 19, 2003 Office Action is unclear.

In response to the first Office Action, an Amendment was filed March 31,

2003. The June 19, 2003 Office Action states that the "Request for Reconsideration" filed on March 31, 2003 has been considered but is

ineffective to overcome the references cited in the first Office Action. The

June 19, 2003 Office Action next states that Applicants' arguments have been

considered but they are moot in view of the new grounds for rejection. Thus it

is unclear whether the June 19, 2003 Office Action is rejecting the claims for

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the same reasons as in the first Office Action or for new reasons.

More significantly, the basis for rejection is unclear. The Office Action states that claims 1, 3, and 6-18 are rejected under 35 U.S.C. §102(b) as being anticipated by either Martineau or Ginter. However in discussing each of these claims, the Office Action concludes by stating that it would have been obvious to apply Ginter's teaching to Martineau's system. A combination is not anticipation under 35 U.S.C. §102(b), although it might be basis for a rejection for obviousness under 35 U.S.C. §103. Thus, the basis for rejection of these claims is unclear.

Further, the Office Action states that claims 4, 5 and 19-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ginter in view of Martineau and further in view of Nokia Mobile Phones Limited International Patent Publication No. WO 00/18205. Attached is a copy of International Patent Publication WO 00/18205. As can be seen, that publication pertains to a patent application owned by Siemens Aktiengesellschaft, is titled Assembly System for Fitting Supports with Componentry, and has nothing to do with the subject matter of the claimed invention.

Turning to the rejections, each of the independent claims 1, 15, 16, 19, 20, 21, 22, 23, and 24 recites tailoring information defining what electronic content is able to be transferred, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred by a terminal device to another terminal device. The claims thus involve tailoring information defining specific things.

The rejections of all of the claims rely upon Martineau and Ginter.

Neither Martineau nor Ginter shows or suggests tailoring information of the type set forth in the claims. Martineau discloses a wireless telephone into which a subscriber identity module (SIM) and a prepaid card can be inserted. The prepaid card can calculate a certificate from the number of prepaid units shown on the card, the card serial number, and a key number in the card. The prepaid card transfers to the SIM the number of prepaid units and the card serial number. The SIM then calculates the key number of the card and a certificate. The certificate calculated in the prepaid card is compared with the certificate calculated in the SIM. An acceptable comparison confirms that a connection may be established so that content may be transferred. However, the certificate does not specify the particular content that is permitted to be transferred. Martineau only controls the length of time that the connection may be maintained; he does not control the specific electronic content that is permitted to be transferred.

Ginter discloses systems and methods for secure transaction management and electronic rights protection. Ginter is concerned with controlling the use of electronic content, not the transfer of electronic content.

With respect to claims 1, 3, and 6-18, the Office Action draws attention to Martineau at Figure 1 and associated text, at column 4 lines 17-38 and to Ginter at the Abstract, Figures 1-2A, 7, 71, 77, and 78, the associated description, column 2, column 8, column 40 line 62 to column 42 line 3, and column 251 lines 4-6. Nothing in those portions of Martineau and Ginter discloses or suggests tailoring information defining what electronic content is able to be transferred, a period of time during which the defined electronic

content is able to be transferred, and whether the defined electronic content can be transferred by a terminal device to another terminal device. Thus each of the independent claims distinguishes in an unobviousness manner from Martineau and Ginter and is allowable. The dependent claims are likewise allowable.

Numerous passages in Ginter show that he is concerned with use of content rather than transfer of content. See Ginter at, for example, column 2 lines 33-36, column 6 lines 57-67, column 9 lines 37-42, column 15 lines 30-31, column 56 lines 19-29, and column 56 line 66 to column 57 line 9. At column 14 lines 36-39 Ginter discusses encryption and decryption of content. This controls use of contents, not transfer of content.

At column 56 lines 7-11 Ginter states that the content creator may specify rules and controls for distributing the content that can specify who has permission to distribute the rights to the content and how many users are allowed to use the content. Still, this does not define what content may be transferred, a period of time during which the content is able to be transferred, and whether the content can be transferred by a terminal device to another terminal device.

37 C.F.R. §1.104 requires that the Examiners action including making a thorough investigation of the available prior art relating to the subject matter of the claimed invention and states that the examination shall be complete as to the patentability of the invention as claimed. Should the Examiner in the present application be aware of any other portions of Martineau or Ginter which are relevant to the patentability of the invention as claimed, he is

requested to bring attention to them so that Applicant may properly respond.

With regard to claim 3, the Office Action brings attention to Figures 77 and 78 of Ginter and associated description. Description of Figure 77 is found at columns 280 and 281. That portion of Ginter talks about handling and control by a client administrator, but nothing was found relating to transmitting of tailoring information from a second terminal device to a third terminal device as called for in claim 3. That portion of Ginter refers to Figure 2 of Ginter. Figure 2 is described commencing at column 56 line 6 which talks about rules and controls for distributing content. Column 56 lines 7-11 are discussed above. At lines 20-22, Ginter states that the rules and controls may specify what a user can and can not do with the content and how much it cost to use the content. At column 57, lines 1-9 Ginter states that the rules and controls may grant specific individuals or classes of content users permission to use certain content. The rules and controls may specify what kinds of content usage are permitted and what kinds are not and may specify how content usage is to be paid for and how much it costs. There is no suggestion in this portion of Ginter of tailoring information relating to specific electronic content that is authorized to be transferable to a terminal device, a period of time during which the defined electronic content is able to be transferred, and whether the defined electronic content can be transferred by the terminal device to another terminal device.

The Office Action, which states that claims 1, 3, and 6-18 were rejected under 35 U.S.C. §102(b) as being anticipated by either Martineau or Ginter, states with respect to claim 7 that Ginter in view of Martineau

discloses all of the imitations of claim 1 and further discloses the limitations of original claim 7. Aside from the fact that Ginter in view of Martineau does not constitute a rejection under 35 U.S.C. §102(b), attention is directed to the fact that claim 7 was cancelled in the Amendment of March 31, 2003.

Claims 4, 5, and 19-31 were rejected under 35 U.S.C. §103(a) as being unpatentable in view of Ginter in view of Martineau and further in view of "Nokia Mobile Phones Limited (Nokia), International Patent Publication No WO 00/18205." This rejection is traversed, and reconsideration and withdrawal of it are requested. The attached copy of International Patent Publication No. WO 00/18205 shows that that publication relates to an assembly system for fitting supports with componentry. That publication does not show what the Office Action contends that it shows. As such, it has no bearing on the claimed invention, and so this rejection should be withdrawn.

Independent claims 1 and 23, along with dependent claims 3-6 and 8-14, recite reading tailoring information from a memory module into a terminal device, comparing the tailoring information with tailoring information in the content or with tailoring information in another terminal device, and if the comparison is favorable transferring the content. Neither Martineau nor Ginter shows this. Thus, these claims are allowable for this further reason.

Significant flaws also exist in the rejections of the remaining dependent claims. In view of the distinctions of all of the claims over the basic references, Martineau and Ginter, it is felt to be unnecessary to elaborate on the other distinctions of the dependent claims at this point and time.

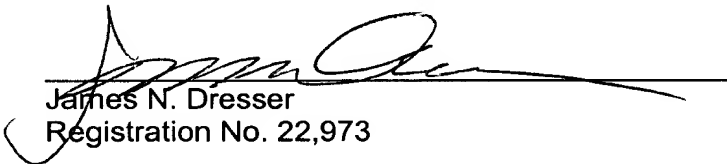
In view of the above, it is urged that the rejection should be withdrawn,

that the claims are allowable, and that the application is in condition for allowance. Such action would be appreciated.

Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 0171.39361X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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Attachments